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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,136	12/18/2001	Stephen W. Comiskey	53326.000012	9781

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EXAMINER	
LORENGO, JERRY A	
ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/020,136	COMISKEY ET AL.	
	Examiner	Art Unit	
	Jerry A. Lorengo	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-47* is/are pending in the application.

4a) Of the above claim(s) *41-47* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *08/01/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

(1)

Election/Restrictions

Applicant's election with traverse of Group I, claims 21-40 in the reply filed on October 27, 2004 is acknowledged. The traversal is on the ground(s) that the claim groups (Group I: claims 21-40 and Group II: claims 41-47) are not related as product and process of use. The Examiner agrees.

The Examiner also submits, however, that this application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: *Claims 21-40*, drawn to a method reducing reflected lightglare into a human's eyes from the human's cheeks using an adhesive decal; and

Species B: *Claims 41-47*, drawn to a method reducing reflected lightglare into a human's eyes from the human's cheeks using an eye black applied via a stencil.

Currently, no claims are generic. Since the Applicant has previously elected claims 21-40 with traverse, claims 41-47 are withdrawn from consideration. As such claims 21-30 will be examined on the merits. The restriction requirement is made FINAL.

(2)

Claim Objections

Claims 23 and 33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations set forth in claims 23 and 33 are not further limiting because the wavelength limitations sets forth therein are previously disclosed in each of their respective independent claims 21 and 31.

(3)

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "few" in claims 24 and 34 is a relative term which renders the claim indefinite. The term "few" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably aprised of the scope of the invention. The use of the term "few" in describing the number of hours within which the decal is applied or removed renders the temporal limitation indefinite.

(4)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21-24 and 31-34 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,719,909 to Micchia et al. in view of U.S. Patent No. 1,300,592 to Essig.

Regarding applicant claims 21 and 31, Micchia et al. disclose a method of reducing light glare into a human's eyes from the human's cheeks comprising the steps of:

(1) Providing a decal (patch) 7 comprising a shaped (kidney) body portion 11 having a light-absorbing, hypoallergenic (non-toxic), exterior black surface 12 (which would have a wavelength falling outside the range of 430 and 690nm) and also comprising a adhesive on the opposite surface 13 (Figures 1-3; column 2, lines 22-41; column 2, lines 49-50).

(2) Placing the decal 7 underneath the human's eyes on the cheek area defined by the zygomatic arch whereby incident light rays directed to the zygomatic arch area is substantially absorbed and refection into the eyes is avoided (column 2, lines 14-21). The method of Micchia et al. is illustrated below:

FIG. 1

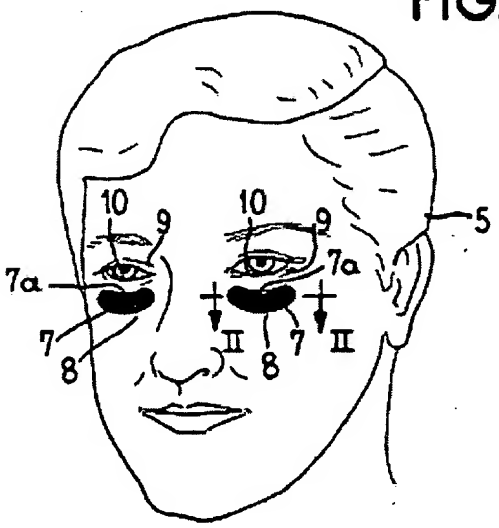


FIG. 2

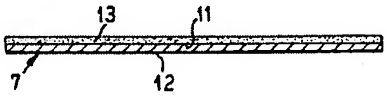
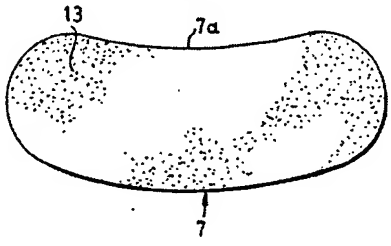


FIG. 3



Although Micchia et al. disclose the overall method and decal structure, they do not specifically disclose, as set forth in applicant claims 21 and 31, that the decal also comprises a shape formed within the exterior surface which has a color contrasting to the non-reflective color and is configured to provide communication.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to provide the decal of Micchia et al. with a shape formed within the exterior surface which has a color contrasting to the non-reflective color in order to provide communication, motivated by the fact that Essig, also drawn to method for the formation and application of adhesively backed removable decals onto the human body, discloses that where a part of the decal (patch) 4 is to be exposed, it is desirable to impart a particular hue or color the exposed (outer or exterior) part of the decal (page 1, column 1, line 45 to page 1, column 2, line 68) such that the whole surface or only parts of the surface have surface ornamenting material applied thereto (page 1, column 2, lines 87-92). Essig further discloses that the ornamenting materials include inks, dyes, flock, tinsel (glitter) and the like (page 1, column 2, lines 68-71; page 1, column 2, lines 101-109). The method of Essig is illustrated below:

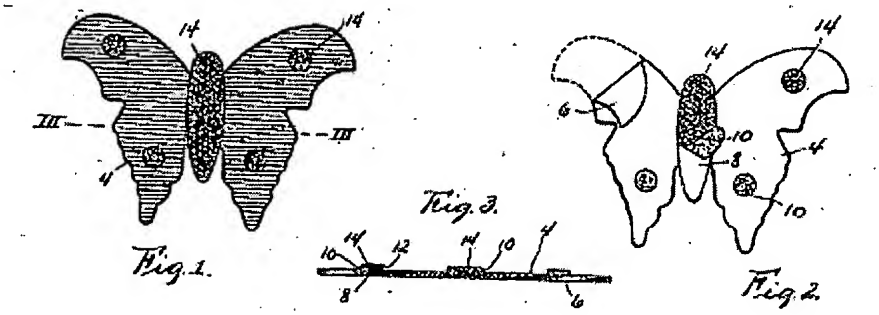


Fig. 4.

As illustrated above, the decal of Essig communicates to the viewer an image of a butterfly.

Although Micchia et al. do not specifically disclose, as per applicant claims 21 and 31, that the decal is removed within a week after application, it would have been obvious to one of ordinary skill in the art at the time of invention that the decal of Micchia et al. would have been removed within this time period motivated by the fact that they disclose that the major utility of the decal 7 is in connection with athletic activity such as football, baseball, basketball, tennis, golf and the like (column 3, lines 17-19) and furthermore by the fact that it is a well-understood general concept that such athletic activities generally span time periods of several hours to one day, but most definitely less than one week.

Regarding applicant claims 22 and 32, Micchia et al. disclose that the decal 7 utilizes a top face 12 comprising a non-reflective portion and a bottom face of pressure sensitive adhesive (PSA) 13 which facilitates the attachment of the decal 7 to the zygomatic cheek portion of the user when applied and pressed thereon (column 2, lines 22-26; column 3, lines 30-34).

Regarding applicant claims 23 and 33, Micchia et al. disclose that the exterior surface 12 of the decal 7 is colored/dyed black which would have a wavelength falling outside the range of 430 and 690nm (column 2, lines 37-41).

Regarding applicant claims 24 and 34, While Micchia et al. disclose that the decal 7 is suitable for use by a participant in an athletic contest (such as in football, baseball, basketball, tennis, golf and the like) and is applied immediately or near the beginning of the start of the contest (such as in the locker room or at the playing field – column 3, lines 3-7), they do not specifically disclose that the decal is removed within a "few" hours or less after the athletic contest or event is over. Nonetheless, the skilled artisan would have been appreciative of the fact that the decal 7 of Micchia et al. would be removed within a short period of time after the conclusion of the athletic contest or event motivated by the fact that it is well-known and generally accepted that equipment specifically designed for use during an athletic event (cleats, pads, etc.) is removed shortly after the conclusion of the event.

(5)

Claims 26-30 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (4), above in further view of U.S. Patent No. 5,470,351 to Ross et al.

Micchia et al. and Essig, as combined in section (4), above disclose a method for the reduction of light glare into a human's eyes from the human's cheeks through the use of a removable PSA decal having an outer light-absorbing portion which may be additionally decorated or modified by the inclusion of a contrasting colored shape or shapes within the outer boundaries of the decal outer (exterior) portion. Although they also disclose that the decal may be formed and decorated in such a manner as to provide communication (such as in the decal of Essig which communicates to the viewer an image of a butterfly), they do not specifically disclose, as per applicant claims 26-30 and 36-40, that the shape of the interior design and/or outer shape of the decal provide communication of a logo, name, or symbol of a sports activity, sport equipment maker, or other entities.

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize the decal resulting from the combination of the Micchia et al. and Essig references to provide communication of a logo, name, or symbol of a sports activity, sport equipment maker, or other entities, as set forth in applicant claims 26-30 and 36-40, [1] motivated by the fact that Ross et al., also drawn to removable PSA decals (column 2, lines 54-58) for temporary application to the human body (column 2, lines 42-44; column 4, lines 5-16), disclose that the decal can be formed in such a way as to provide a precise shape forming a pattern, words or logo (column 2, lines 50-53). Furthermore, the specifics of the claimed pattern would have been the result of obvious design choice by the skilled artisan.

(6)

Claims 25 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over as being unpatentable over the references as combined in section (4), above in further view of U.S. Patent Nos. 5,470,351 to Ross and 4,522,864 to Humason et al.

Micchia et al. and Essig, as combined in section (4), above disclose a method for the reduction of light glare into a human's eyes from the human's cheeks through the use of a removable PSA decal having an outer light-absorbing portion which may be additionally

[1] Note to Applicant regarding applicant claims 26-30 and 36-40: With regards to aesthetic design changes, it has been held (*In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947)) that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.

decorated or modified by the inclusion of a contrasting colored shape or shapes within the outer boundaries of the decal outer (exterior) portion. Although they also disclose that the decal may be formed and decorated in such a manner as to provide communication (such as in the decal of Essig which communicates to the viewer an image of a butterfly), they do not specifically disclose, as per applicant claims 25 and 35, that the decal is provided in the form of a tattoo and applied via transfer from a carrier substrate under the application of moisture and pressure.

Humason et al., however, also drawn to methods for the formation of decals for application to the human body via transfer, i.e., tattoos, disclose a process comprising the steps of:

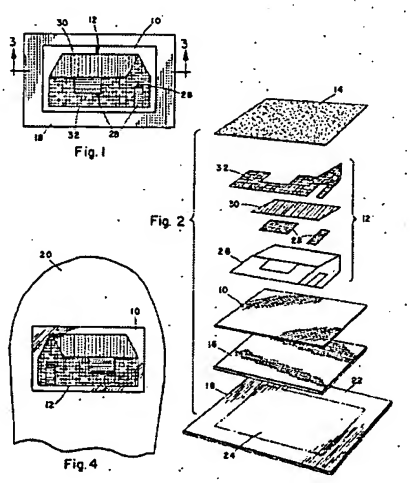
(1) Providing a carrier substrate (decal paper) 18 having a plurality of decorative layers 12 disposed thereon wherein the decorative layers 12 define an exterior shape with contrasting colored shape or shapes within the outer boundaries of the decal in such a manner as to provide a communication - the decal tattoo of Humason et al. communicates to the viewer an image of a house (column 2, line 66 to column 3, line 42);

(2) Providing a clean skin surface 20;

(3) Pressing the side of the carrier substrate 18 having the plurality of decorative layers 12 against the surface of the skin 12;

(4) Wetting the exposed surface of the carrier substrate 18 with water during the pressing to ensure adhesion of the decorative layers 12 to the skin; and

(5) Peeling the carrier substrate 18 from the decorative layers 18 adhered to the skin surface (column 3, lines 43-55). The method of Humason et al. is illustrated below:



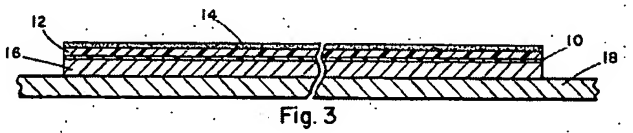


Fig. 3

It would have therefore been obvious to one of ordinary skill in the art at the time of invention to apply the decal resulting from the combination of the Micchia et al. and Essig references in the form of a transferable tattoo, as suggested by Humason et al., motivated by the fact that Ross et al., also drawn to removable PSA decals (column 2, lines 54-58) for temporary application to the human body (column 2, lines 42-44; column 4, lines 5-16), disclose that the application of the decal by transfer from a carrier substrate is often preferable because the use of a carrier substrate avoids the crumpling or folding of the decal which could occur if application of the decal is attempted by removing it directly from its backing without the use of a transfer sheet (column 3, lines 34-47; column 4, lines 5-16).

(7)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry A. Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J.A. Lorengo, Primary Examiner
AU 1734
January 6, 2005